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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/511,717

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David Kempself

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EXAMINER

NGUYEN, SON T

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/511,717	Applicant(s) KEMPSELL ET AL.	
	Examiner Son T. Nguyen	Art Unit 3643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 1-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 23,25-31,33-42,44** are rejected under 35 U.S.C. 103(a) as being unpatentable over Amos (914546).

For claim 23, Amos teaches a saddle tree comprising a tree body 1 having a pommel end (see fig. 6, near ref. 17) and a cantle end (see fig. 6, near ref. 16 right side), the tree body being formed from a flexible material allowing lateral flexing of the tree (page 1, left column, line 25, resilient metal) and a generally X or V-shaped strengthening bar 14 wherein the forks of the X or V-shape are directed towards the cantle end of the saddle tree and whereby the strengthening bar inhibits the transmission of forces from the pommel end to the cantle end due to when a force is apply, say at ref. 15 in fig. 7, it will travel along the bar to the middle near ref. 16 and disconnect. However, Amos's strengthening bar is not Y-shaped. It would have been an obvious substitution of functional equivalent to substitute the X or V-shaped strengthening bar of Amos with a Y- shaped strengthening bar, since a simple substitution of one known element for another would obtain predictable results, i.e. both shapes of strengthening bar would perform the same function to provide strength and

rigidity to the saddle tree, and to disconnect the force if the force exists at the pommel area. KSR International Co. v. Teleflex Inc., 127 S. Ct. 1727, 1739, 1740, 82 USPQ2d 1385, 1395, 1396 (2007).

For claim 25, Amos teaches wherein the pommel end of the saddle tree is angularly adjustable since the material of the saddle tree is resilient metal as disclosed on page 1, left column, line 25.

For claim 26, Amos teaches a head plate 10 located near to the pommel end.

For claim 27, Amos teaches wherein the head plate is malleable (see page 2, lines 14-30).

For claim 28, Amos teaches wherein the head plate is securable in an aperture located in the saddle tree (see fig. 1, the holes where the screws are located therein to attach the plate 10 to the tree).

For claim 29, Amos teaches wherein the head plate is formed integrally within the saddle tree. Integrally is considered as a whole unit.

For claim 30, Amos teaches a metallic head plate but not formed from malleable steel. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the head plate of Amos out of a malleable steel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious choice. See Sinclair & Carroll Co. v. Interchemical Corp., 325 U.S. 327, 65 USPQ 297 (1945) and In re Leshin, 125 USPQ 416.

For claim 31, Amos teaches two recessed portions, one at either side of the tree near to the pommel end, in which stirrup bars are securable. Recesses are located near ref. 8 in fig. 6.

For claim 33, Amos teaches girth web apertures 9 located at both the pommel and the cantle end.

For claims 34-42,44, Amos teaches a saddle comprising the saddle tree above. It is inherently taught in Amos that the saddle tree is used with a saddle (see also page 2, left column, lines 25-30, where Amos states that the tree has fasteners for connection to a cover of the saddle).

3. **Claim 24** is rejected under 35 U.S.C. 103(a) as being unpatentable over Amos as applied to claim 23 above, and further in view of Swain (6363698).

Amos is silent about the strengthening bar being made from carbon fibre.

Swain teaches a saddle tree comprising a strengthening bar 8 made out of carbon fibre (col. 2, line 40). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the strengthening bar of Amos out of carbon fibre as taught by Swain, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious choice. See *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945) and *In re Leshin*, 125 USPQ 416.

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4. **Claims 32 & 43** are rejected under 35 U.S.C. 103(a) as being unpatentable over Amos as applied to claim 23 above, and further in view of Worcester (2130442) and Swain (as above).

For claim 32, Amos is silent about a sheet of bi-directional carbon fibre applied to at least one of the upper and lower surfaces.

Worcester teaches a sheet 7 of reinforcement made out of iron applied to the upper surface of a saddle tree 2. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a sheet of reinforcement as taught by Worcester on the upper surface of the saddle tree of Amos in order to strengthen and reinforce the saddle tree.

As mentioned above, Swain teaches, in col. 2, lines 39-42, carbon fibre is a well known flexible material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the sheet of Amos as modified by Worcester out of carbon fibre as taught by Swain, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use (for flexibility) as a matter of obvious choice. See *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945) and *In re Leshin*, 125 USPQ 416.

For claim 43, Amos teaches a saddle comprising the saddle tree above. It is inherently taught in Amos that the saddle tree is used with a saddle (see also page 2, left column, lines 25-30, where Amos states that the tree has fasteners for connection to a cover of the saddle).

Response to Arguments

5. Applicant's arguments filed 3/25/08 have been fully considered but they are not persuasive.

Applicant argued that the tree of Amos is rigid because Applicant respectfully contends that the correct grammatical interpretation of Amos is that Amos requires (at page 1, lines 44-48): "in order to cause the tree to possess sufficient rigidity to prevent undue yielding...the pommel has combined with itan arch plate." Amos is clearly referring to rigidity of the tree per se, not just holding the tree on the horse in an unyielding manner. The arch plate serves to "strengthen the pommel against yielding" (page 2, lines 18-20) as it is manufactured of thick (Fig 2) metal (page 2, line 16). Additionally, the tree body is formed with reinforcing wires 5 and 6 to "reinforce the tree against yielding (page 1, lines 100-103) and wires or bars 18 are provided between member 15 to prevent spreading (page 2, lines 68-73). It would be clear to the person skilled in the art that Amos fundamentally teaches a rigid tree.

It is not clear to one of ordinary skill in the art when reading the above excerpts that Amos teaches a "rigid" tree because, clearly, the material used in manufacture the tree body is a resilient metal (page 1, line 25), which is a flexible material. All other elements, such as the arch plate, the reinforcing wires, etc. mentioned by Applicant are there to further reinforce the tree body because the body might be too flexible or resilient. If anything, these excerpts suggested by Applicant clearly state that the tree body is flexible and not the opposite, i.e. rigid, as alleged by Applicant. Even if

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considering these elements, i.e. the arch plate and the reinforcing wires, both of these elements are also made out of flexible material to impart somewhat resiliency (see page 1, lines 100-106 and page 2, lines 15-25), and if the tree body and these elements are taken as a whole, then clearly they are flexible more than rigid. In addition, the comment regarding "in order to cause the tree to possess sufficient rigidity to prevent undue yielding", this has nothing to do with the tree material; instead, Amos is saying that the girth loops which are adapted for connection with the stirrup straps holds the tree rigid to prevent undue yielding when placing the saddle tree on a horse and not that the tree is made out of a rigid material.

Applicant argued that while the sheet metal may be per se "resilient" if it is to function as a basis for a saddle, it needs to be provided with a rigid frame and rigid support such that the tree body as a whole is rigid. If it is not rigid, it will yield under the pressures of riding and once deformed will remain deformed potentially causing substantial injury to the horse. One skilled in the art will appreciate that although the saddle tree of Amos is fabricated from sheet metal, the tree body as a whole must be made rigid to provide sufficient support for the sheet metal to resist damage to the sheet metal and injury to the horse.

It is true that in the saddle industry, the saddle has to be made with certain degree of rigidity, but this doesn't mean that the saddle cannot be flexible or resilient to absorb shock from riding. The saddle does not have to be stiff because this can be uncomfortable for the rider and the horse. Clearly from all the "hints" in Amos, Amos' saddle tree or tree body is definitely not stiff or so rigid that there is no flexibility. In

addition, what degree of rigidity is Applicant referring to because there are different degrees of rigidity or hardness. In any event, the argument is geared elsewhere because Applicant claim language calls for the tree body being formed from a flexible material, to which the tree body of Amos is formed from a resilient metal which is a flexible material. Applicant is side tracking to other elements that are not even the tree body to argue that the body is rigid.

Applicant argued that in contrast thereto, the present invention, by having a Y-shaped strengthening bar, disconnects forces impacting upon the pommel region of the saddle tree thereby preventing these forces from being transmitted through the "bar" to the cantle end of the saddle tree. Accordingly, a Y-shaped strengthening bar is not functionally equivalent to an X or V-shaped bar. The same distinction applies with respect to Swain. A substantial impact upon one of the strips 15 of Amos or the equivalent in Swain will result in a permanent twisting of the saddle tree. In contrast, in the present invention, the disconnection allowed by the use of a Y-shaped bar prevents permanent twisting of the saddle tree, meaning that any twisting of the pommel end side is absorbed and reversible, maintaining the comfortable fit of the saddle on the back of the horse.

Applicant's allegation is without merit because Applicant has not proven with evidence that a force would disconnect and not travel along the bar by using a Y-shaped versus an X or V-shaped. It does not make sense how the force just disconnect or not be transmitted for the Y-shaped versus the X or V-shaped because it is believed that it would be the same or at least similar. For example, in comparing both Amos and

Applicant, for Amos, assuming a force hit in the area of the pommel near the opening in fig. 7 of Amos, the force would split and travel along the forks and lessen (due to time) as it approaches the cantle. This is the same as Applicant if a force was to hit in the area of the pommel, the force would split and travel along the forks and lessen (due to time) as it approaches the cantle. Thus, it is not clear how Applicant believes that his Y-shaped bar is any different as far as the travel path of the force along the bar, especially the non-forked area of the Y-shaped of Applicant is shown so short. In addition, Applicant's mere allegation that the strips 15 of Amos will be permanently twisted is nothing more than a mere allegation with proof or evidence. In conclusion, it is believed that the Y-shaped of Applicant (especially with the non-forked portion near ref. 106 being so short) and the X or V-shaped of Amos are functional equivalent since they both will inhibit transmission of force to the cantle over time.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son T. Nguyen whose telephone number is 571-272-6889. The examiner can normally be reached on Mon-Thu from 10:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on 571-272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Son T. Nguyen/
Primary Examiner, Art Unit 3643